

REMARKS

Claims 1 and 3-13 are pending in this application. By this Amendment claims 1, 3-7, 9 and 10 are amended. Paragraphs 0007, 0008 and 0015 of the specification are also amended in accordance with the aforementioned claim amendments. No new matter is entered.

In the Advisory Action mailed April 5, 2005 the Examiner refused to enter the Amendment After Final Rejection based on new issues raised by the Amendment. As pointed out by the Examiner, claims 1 and 3-13 were rejected as being indefinite under 35 USC §112, second paragraph. Claims 11-13 were not, however, rejected over the prior art despite having been added in the amendment submitted August 23, 2004. Applicant notes that indefinite limitations must be considered pursuant to MPEP §2143.03:

A claim limitation which is considered indefinite cannot be disregarded. If a claim is subject to more than one interpretation, at least one of which would render the claim unpatentable over the prior art, the examiner should reject the claim as indefinite under 35 U.S.C. 112, second paragraph (see MPEP § 706.03(d)) and should reject the claim over the prior art based on the interpretation of the claim that renders the prior art applicable. *Ex parte Ionescu*, 222 USPQ 537 (Bd. Pat. App. & Inter. 1984) (Claims on appeal were rejected on indefiniteness grounds only; the rejection was reversed and the case remanded to the examiner for consideration of pertinent prior art.). Compare *In re Wilson*, 424 F.2d 1382, 165 USPQ 494 (CCPA 1970) (if no reasonably definite meaning can be ascribed to certain claim language, the claim is indefinite, not obvious) and *In re Steele*, 305 F.2d 859, 134 USPQ 292 (CCPA 1962) (it is improper to rely on speculative assumptions regarding the meaning of a claim and then base a rejection under 35 U.S.C. 103 on these assumptions).

Objections to the Specification

In the Final Rejection dated November 30, 2004, the specification was objected to as failing to provide proper antecedent basis for the claimed subject matter. By this

Amendment, the independent claims are amended to remove the language added to them in the Amendment filed August 23, 2004 and to further define the free axial end of the axially extending annular leg. The specification has also been amended accordingly. Support for the language added to the claims and written specification is found in the drawings as originally filed. As a result, it is respectfully submitted that the objection is overcome and should be withdrawn.

Rejections under 35 USC §112, second paragraph

In the Office Action, claims 1-13 were rejected under 35 U.S.C. §112, second paragraph. Applicant understands this rejection to be based on claims 1 and 3-13, as claim 2 was previously canceled by Amendment on September 9, 2003. In any event, the amendments made to claims 1, 9 and 10 in the August 23, 2004 Amendment are hereby reversed by this amendment. Furthermore, claims 1, 9 and 10 and paragraphs 0007, 0008 and 00015 of the specification are herein revised to more clearly define the free axial end of the axially extending annular leg of the slide ring. As a result, it is respectfully submitted that the rejection is moot and should be withdrawn.

Rejections under 35 USC §103

Claims 1 and 3-10 were rejected under 35 U.S.C. §103 over Morley et al (US 4,421,327) in view of Zutz (US 5,762,343). Claims 1 and 3-10 were also rejected under 35 U.S.C. §103 over Morley figures 1-5 (first embodiment) in view of Morley figure 6 (second embodiment) and Zutz. The rejections are respectfully traversed. Claims 11-13 have not yet been rejected based on the prior art of record.

The test for obviousness is what the combined teachings of the prior art would have

suggested to one of ordinary skill in the art. See, e.g., In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a prima facie case of obviousness, it is incumbent upon the Examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). Additionally, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). See MPEP §2143.03.

Amended claims 1, 9 and 10 recite, in relevant part, a slide ring having an L-shaped cross-section with an axially extending annular leg, said leg having radially outer and radially inner circumferential surfaces and a free axial end surface. Claims 1, 9 and 10 further recite a plurality of circumferentially spaced **recesses extending axially inward from said free axial end surface** of said leg. It is respectfully submitted that neither Morley nor Zutz teaches a slide ring seal assembly as recited in claims 1, 9 and 10.

As recognized by the Examiner, Morley fails to disclose or teach a plurality of circumferentially spaced recesses extending from the radially outer circumferential surface to a radially inner circumferential surface of the axially extending leg (see page 3 of Office Action mailed 4/21/04). In order to overcome this deficiency, the Examiner applies the teachings of Zutz, in particular the teachings of this reference with regard to the counterring 2. Zutz teaches a particular manner of attaching a sealing element 4 to a radially extending counterring 2. Specifically, Zutz teaches an

aperture 7 in the radially extending counterring 2 through which the elastomer material of the sealing ring 4 extends in order to improve adherence. Based on this teaching, the Examiner asserts that the slide ring seal assembly recited in claims 1, 9 and 10 would be obvious to one having ordinary skill in the art at the time the invention was made. This position is respectfully traversed in view of the amendments to claim 1, 9 and 10 made herein.

In particular, claims 1, 9 and 10 have now been amended to recite that the plurality of circumferentially spaced recesses extend axially inward from a free axial end surface of the axial leg of the slide ring. It is respectfully submitted that neither Morley nor Zutz teaches such recesses on an axial leg of a slide ring to prevent rotation of a sealing body seated thereon. Zutz plainly shows the aperture 7 as a hole extending through the radial leg of counterring 2 and positioned inward of the outermost circumferential surface of the counterring 2. Accordingly, it would not have been obvious to one having ordinary skill in the art at the time the invention was made to modify the axial leg of the slide ring of Morley to include recesses which not only extend radially through the axial leg but also axially inward from a free axial end surface.

Furthermore, claims 11-13 recite the annular sealing body being removably in contact with the leg such that the annular sealing body can be moved out of contact with the leg without damaging the annular sealing body. In contrast, Zutz teaches that the sealing body 4 is vulcanized to the counterring 2 (see Zutz column 2 line 66 – column 3 line 3). That is, the sealing body 4 of Zutz is immovably connected to the counter ring 2 by vulcanization. Accordingly, it is respectfully submitted that the combination of Morley and

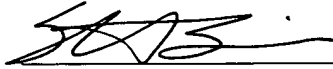
Zutz fails to render obvious the instant invention as recited in claims 11-13.

In view of the forgoing, it is respectfully submitted that the application, including claims 1 and 3-13, is in condition for allowance. Favorable consideration and prompt allowance are respectfully requested.

If the Examiner is of the opinion that the prosecution of the application would be advanced by a personal interview, he is invited to telephone undersigned counsel and arrange for such an interview.

Respectfully submitted,

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